

REMARKS

By this Amendment, Applicant amends claims 1, 6, and 8 to more appropriately define the present invention. Applicant also adds new claims 14-16 to address other aspects of the present invention. Upon entry of this Amendment, claims 1, 3-8, 10, 11, and 14-16 will be pending.

Applicant also notes that the Examiner has not acknowledged the Information Disclosure Statement (IDS) filed on May 25, 2001. Applicant respectfully requests that the Examiner returns an initialized Form PTO 1449 to indicate the consideration of the references cited in the IDS filed on May 25, 2001.

In the final Office Action, the Examiner rejected claims 1-4, 6-10, 12, and 13 under 35 U.S.C. § 102(b) as anticipated by United Kingdom Patent No. 2311910A to Robinson et al. ("Robinson"); and rejected claims 5 and 11 under 35 U.S.C. § 103(a) as unpatentable over Robinson in view of U.S. Patent No. 6,704,813 to Smirnov et al. ("Smirnov").¹ Applicant respectfully traverses the Examiner's rejection under both § 102 and § 103.

Regarding Claim Rejection under 35 U.S.C. § 102

Applicant respectfully traverses the Examiner's rejection of claims 1-4, 6-10, 12, and 13 under 35 U.S.C. § 102(b) as anticipated by Robinson. Applicant respectfully points out that claims 2, 9, 12, and 13 had been canceled by the Amendment filed on November 12, 2004. Applicant thus does not include a response to the rejection of claims 2, 9, 12, and 13 (the rejection of claims 2, 9, 12, and 13 is moot).

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

To anticipate Applicant's claimed invention under 35 U.S.C. § 102, each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); emphasis added.

Independent claim 1, as amended, recites a combination including, for example, "second communication means for establishing a second radio channel with the base station and for making communications with a second communication entity different from the first communication entity over the second radio channel simultaneously with the first communication means." Robinson fails to disclose at least the above element of amended claim 1.

Robinson teaches "a modular radio communication device, wherein different modules provide access to different radio communication services." Robinson, page 3, lines 16-18. "Upon adding or deleting modules to and from the radio communication unit, the radio communication system reconfigures the channel providing radio communication services to the radio communication unit." Robinson, page 3, lines 19-22. "For example, if the communication will only involve voice communications, then the bandwidth assigned may be 9.6 kilobits/second. If the communication will involve voice and video communications, then the bandwidth assigned may be 64 kilobits/second." Robinson, page 7, lines 16-20, emphasis added. However, Robinson's teaching of changing the bandwidth of an assigned channel does not constitute a teaching of "second communication means for establishing a second radio

channel with the base station and for making communications with a second communication entity different from the first communication entity over the second radio channel simultaneously with the first communication means," as recited by amended claim 1 (emphasis added).

Therefore, Robinson fails to disclose each and every element of amended claim 1. Robinson thus cannot anticipate under 35 U.S.C. § 102 Applicant's claimed invention recited in claim 1. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 1. Since claims 3 and 4 depend from claim 1, Applicant also requests withdrawal of the rejection of claims 3 and 4 for at least the same reasons stated above.

Independent claims 6 and 8, while of different scope, recite similar elements to that of claim 1. Claims 6 and 8 are therefore also allowable for at least the same reasons as stated above. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 6 and 8, and claims 7 and 10, which depend from claims 6 and 8, respectively.

Regarding Claim Rejection under 35 U.S.C. § 103

Applicant respectfully traverses the Examiner's rejection of claims 5 and 11 under 35 U.S.C. § 103(a) as unpatentable over Robinson in view of Smirnov. In order to establish a prima facie case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143, emphasis added.

Claim 5 depends from claim 1. With respect to claim 1, Robinson fails to teach or suggest at least "second communication means for establishing a second radio channel with the base station and for making communications with a second communication entity different from the first communication entity over the second radio channel simultaneously with the first communication means," as recited by claim 1.

Smirnov fails to cure Robinson's deficiencies. Smirnov discloses a system for storing streaming information. "Streaming information can be received by computer 20 using a number of known methods and technologies. Commonly, a source of streaming information is a remote computer wherein computer 21 is connected to the remote computer using a wired or wireless modem." Smirnov, column 4, lines 51-55. However, Smirnov does not suggest or teach at least "second communication means for establishing a second radio channel with the base station and for making communications with a second communication entity different from the first communication entity over the second radio channel simultaneously with the first communication means," as recited by amended claim 1 (emphasis added).

Therefore, neither Robinson nor Smirnov, taken alone or in any reasonable combination, teaches or suggests all claim elements recited in claim 1. A prima facie case of obviousness has not been established with respect to claim 1. Claim 1 is thus allowable over Robinson in view of Smirnov. Because claim 5 depends from claim 1, claim 5 is also allowable for at least the reason as being dependent on an allowable base claim. Accordingly, Applicant respectfully requests withdrawal of the Section 103(a) rejection of claim 5.

Claim 11 depends from independent claim 8. Claim 8, while of different scope, recites similar language to that of claim 1. Claim 8 is therefore also allowable for at least the same reasons stated above. Claim 11 is thus also allowable for at least the reason as being dependent on an allowable base claim. Accordingly, Applicant respectfully requests withdrawal of the Section 103(a) rejection of claim 11.

Regarding Newly Added Claims

Applicant has added claims 14-16 to address other aspects of the present invention. Support for claims 14-16 may be found at, for example, page 18 of the specification. Applicant respectfully submits that claims 14-16 are neither anticipated nor rendered obvious by the prior art of record.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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